

Appl. No. 09/686,563
Amdt. dated June 28, 2004
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

REMARKS/ARGUMENTS

Claims 1 and 11 were pending in this application. No claims have been amended, added, or cancelled. Hence, claims 1 and 11 remain pending. Reconsideration of the subject application is respectfully requested.

Claims 1 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,633,545 to Milbrandt, *et al.* (hereinafter "Milbrandt"), and further in view of the cited portions of U.S. Patent No. 5,404,400 to Hamilton, *et al.* (hereinafter "Hamilton").

Claim Rejections Under 35 U.S.C. § 103(a)

The Applicants respectfully traverse the rejection of all claims because the office action has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP § 2143) Here, the office action has not met all three criteria. Specifically, the office action has not shown that the prior art teaches or suggests all the claim limitations, the office action does not cite a reference that teaches or suggests a motivation to combine reference teachings, and the office action ignores the fact that the cited references address different problems and thus could not be successfully combined.

For example, with respect to claim 1 and the third prong of the test, a number of limitations are not present in the cited references and are not even addressed by the office action. Specifically, the cited references do not teach "a dialog processing device ... and software that programs the system to ... use the dialog processing device to monitor the terminating connection during operation of the modem [and] classify the terminating connection as an ISDN modem if the dialog processing device detects an ISDN modem at the terminating connection." With

Appl. No. 09/686,563
Amdt. dated June 28, 2004
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

respect to the portion of this limitation relating to monitoring the terminating connection, the office action references Milbrandt at Col. 10, lines 36-52. At this location, however, Milbrandt repeatedly refers to monitoring and characterizing "subscriber lines," which is not equivalent to monitoring a "terminating connection" as the Applicants claim. Further, the office action does not address, and the references do not teach the portion of this limitation relating to classifying the terminating connection as an ISDN modem."

The office action also does not address:

"use[ing] the modem to attempt to establish an analog modem connection to a terminating connection;"

"classify[ing] the terminating connection as an analog modem if the modem successfully establishes a connection to the terminating connection at a negotiated maximum baud rate greater than about 1000 bits/sec;" and

"classify[ing] the terminating connection as a voice connection if the dialog processing device detects a voice connection."

Thus, claim 1 is allowable at least for the reason that the cited references fail to teach all the claim limitations.

Moreover, however, claim 1 is allowable since the office action does not cite a reference in the prior art that provides the necessary motivation or suggestion to combine the teachings of Milbrandt with those of Hamilton to achieve the Applicant's claimed invention.

The Applicants note that,

[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

(MPEP § 2143.01) The office action states that the motivation, "to communicate with a facsimile machine," is found in the abstract of Hamilton. This alleged motivation, however, fails to address the shortcomings in the references. Milbrandt relates to testing subscriber lines. There is no reason that someone employing the teachings of Milbrandt to test subscriber lines

Appl. No. 09/686,563
Amdt. dated June 28, 2004
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

would desire to communicate with a facsimile machine. The motivation arises only in light of the Applicant's teachings, and to suggest the motivation is present in the prior art amounts to impermissible hindsight. Thus, claim 1 is allowable for this additional reason.

Further still, combining the references would fail to achieve the Applicant's invention. As stated previously, Milbrandt generally relates to determining the data rate capability of a subscriber line. Hamilton, on the other hand, relates to an outcalling apparatus. Combining these unrelated technologies would not produce the Applicant's claimed invention even if one were motivated to construct the combination. Thus, claim 1 is allowable for this additional reason.

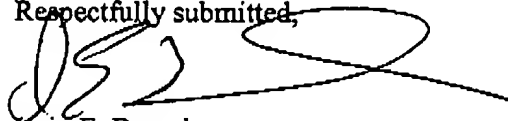
Claim 11 includes similar limitations and is allowable for similar reasons.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Irvin E. Branch
Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
IEB:arl
60218552 v1